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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,142	07/23/2001	Reto Sieber	F-7086	4481

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JORDAN AND HAMBURG LLP
122 East 42nd Street
New York, NY 10168

EXAMINER

EGAN, BRIAN P

ART UNIT	PAPER NUMBER
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1772

7

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,142

Applicant(s)

SIEBER ET AL.

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claim 1 limitation “wherein the protective film has at least one slit in a longitudinal direction and the tape is folded upon itself in a transverse direction along the slit in such a manner that at least a portion of the protective film is disposed on the outside and that at least a lateral longitudinal section is provided, said section being perforated” must be shown or the feature(s) canceled from the claim(s). It is unclear how the tape structure in claim 1 can be folded in such a way as to result in the tape structure of tape
2. No new matter should be entered.

Furthermore, it is unclear whether Fig. 1 is a cutaway view of the adhesive tape wherein the layers are staggered solely to demonstrate the arrangement of the multiple layers such that the three layers are actually aligned with one another, or if Fig. 1 is a depiction of the actual alignment of the material layers.

The claim 7 limitation of an “intermediate layer” and the claim 9 limitation of “means ... for preventing adhesion to the dispenser” also must be shown or the feature canceled from the claims.

The claim 11 limitation of “two lateral longitudinal sections” is unclear – it is unclear whether these longitudinal sections are in reference to either the backing layer or protective film layer, or if these sections are separate and distinct from the backing and protective layers. If the longitudinal sections are distinct from the backing or protective film layers, the feature must be shown in the Figures or canceled from the claims.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: page 2 of the specification references claim numbers, specifically Claims 1 and 17. Referencing specific claim numbers within the specification is improper. Furthermore, it creates a burden on both the applicant and the examiner to continually check that the referenced claim numbers within the specification match with what the claims are actually claiming – here, the specification makes reference to a dispenser in claim 17 – the claims have already been amended such that the dispenser is first claimed in Claim 8, thereby rendering the specifications reliance on claim 17 improper.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites, "wherein the protective film has at least one slit in a longitudinal direction and the tape is folded upon itself in a transverse direction along the slit in such a manner that at least a portion of the protective film is disposed on the outside and that at least a lateral longitudinal section is provided, said section being provided." None of the figures accurately depict the tape being "folded upon itself" and it is indeterminable whether the tape is actually folded upon itself or whether the applicant is claiming the tape to comprise a longitudinally extending pressure line or crease, which is generally known as a "fold line" in the pressure-sensitive adhesive tape art. Although Fig. 2 is disclosed to be an assembly adhesive of Fig. 1, a portion of which has been folded, it is not clear how such a formation was made. If the tape of fig. 1 is folded along the slit (6), Fig. 2 should have an extended portion such that there is a portion of exposed adhesive (2) and the backing layer would be in an L-formation around the protective film. Only if Fig. 1 is a cutaway view of the multilayered tape such that the three layers are actually aligned with one another allows the Fig. 2 embodiment to be enabling, but the applicants do not state that Fig. 1 is a cutaway view of the tape structure. For examination purposes, the Examiner is defining Fig. 1 to be a cutaway view of the adhesive tape structure such that the three layers are actually aligned with one another, thereby rendering Fig. 2 a clear depiction of the tape being folded upon itself. Proper clarification and/or correction are required.
6. Claim 7 is further rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification states that an intermediate layer is provided at least at the folded side of the roll. The figures fail to depict the existence of an intermediate layer and it is not to defined or described in the specification in such a way as to enable one skilled in the art to use the invention. Is the intermediate layer a release coating? A paper or film layer? Proper clarification and/or correction are required.

7. Claim 9 is further rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The “means... for preventing adhesion to the dispenser” are not adequately defined as to enable one skilled in the art to make or use the invention. Proper clarification and/or correction are required.

8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The phrase, “at least a portion of the protective film is disposed on the outside,” is indefinite. It is unclear where “outside” is in relation to the structure. Furthermore, the phrase, “a lateral longitudinal section” is indefinite for the same reasons – it is unclear where this “lateral section” is located in relation to the overall structure. Proper clarification and/or correction are required.

9. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The term, “hand tearable,” is indefinite. It is unclear how strong the tape actually is and how

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much force must be applied in order to tear the substrate. Proper clarification and/or correction are required.

10. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The term, “folded side,” lacks a proper antecedent basis and is therefore indefinite. What is the “folded side” in relation to? Is it in relation to the edge which is folded? The top or bottom of the substrate? Proper clarification and/or correction are required.

11. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The phrase, “adapted for” is indefinite. Either the dispenser is for unrolling the tape or it is not. Proper clarification and/or correction are required.

12. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. It is unclear whether the limitation, “wherein two lateral longitudinal sections, which are perforated,” is in reference to the backing layer or protective liner, or if the “lateral longitudinal sections” are a completely distinct feature to the article. If the “lateral longitudinal sections” are distinct features, the figures fail to demonstrate such feature. Proper clarification and/or correction are required.

13. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The term, “good adhesion properties,” is indefinite. It is unclear what constitutes “good” properties. Proper clarification and/or correction are required.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-3, 5-6, 10-12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vitale (#4,792,473) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307).

Vitale teaches a pressure sensitive tape for closing, sealing, or gluing joints in house construction, including joints in corners and edges (Col. 1, lines 5-22), comprising a backing layer (Fig. 1, #12), an adhesive layer supported by the backing layer (Fig. 1, #14), and a peelable protective film resting on the adhesive layer (Fig. 1, #18). The backing comprises paper (which is an open pored material) (Col. 1, lines 59-60) that exhibits good adhesion properties for plaster ("gypsum"; Col. 1, line 67 to Col. 2, line 10) and the adhesive layer is a pressure-sensitive acrylate adhesive (Col. 3, line 16-17). The adhesive layer has a non-adhering central strip (Col. 3, lines 32-33). The tape is at least 3 to 4cm wide when not folded (Col. 2, lines 47-49). The backing comprises a longitudinal section comprising circular perforations with an average diameter of at least 3 millimeters (Col. 2, lines 60-64). The adhesive tape is in the form of a roll (Col. 3, lines 47-50).

Vitale fails to teach the protective layer comprising multiple slits and the tape being folded upon itself in a transverse direction along a slit.

Hibler, however, teaches a protective tape for protecting corners wherein the protective film is slit (“scored”) along the adhesive portions of the substrate. Hibler teaches the use of slits along the protective film layer for the purpose of allowing one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner (Col. 4, lines 30-35). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made, motivated by the desire to properly adhere a tape along the corner portion of a wall, to have provided slits along the adhesive portions a protective film layer of a tape substrate for the purpose of allowing one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner as taught by Hibler.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Vitale by slitting the protective film layer along each adhesive portion (thereby making two parallel score lines along the dotted lines depicted as #30 in Fig. 1) as taught by Hibler in order to allow one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner.

Tuoriniemi teaches a masking tape for corner structures wherein the tape is folded upon itself in a transverse direction (see Figs. 6(a-e)). Tuoriniemi teaches the rolled construction wherein the tape is folded upon itself for the purpose of allowing the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the tape to be unfolded and bonded along the other edge of the corner – thereby simplifying the application process (Col. 4,

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lines 46-54). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided a roll of adhesive tape used for corner structures with a tape in a folded over relationship for the purpose of allowing the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the outer adhesive layer to be bonded along the other edge of the corner – thereby simplifying the application process – as taught by Tuoriniemi.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Vitale by providing the rolled tape in a folded over relationship as taught by Tuoriniemi in order allow the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the outer adhesive layer to be bonded along the other edge of the corner – thereby simplifying the application process.

16. Claims 1-3, 5-6, and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loscuito (#5,264,775) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307).

Loscuito teaches a pressure-sensitive tape for closing, sealing, or gluing joints in house construction, including joints in corners and edges (Col. 2, lines 14-17), comprising a backing layer (Col. 1, lines 3-6), and adhesive layer supported by the backing layer (Col. 1, lines 6-8), and a peelable protective film resting on the adhesive layer (Col. 2, lines 8-10). The adhesive tape has multiple longitudinal perforated sections wherein the perforations extend through all three layers (see Fig. 1; Col. 3, lines 25-28). The perforations are at least 3 millimeters in diameter and are in the shape of circles, ovals, stars, or any other desired shape (Col. 2, lines 32-43). The backing comprises paper (which is an open pored material) (Col. 2, lines 3-6) which exhibits good adhesion properties for plaster (Col. 3, lines 20-23) and the adhesive layer is a

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pressure-sensitive acrylate adhesive (Col. 2, lines 6-7). The tape is at least 3 to 4cm wide when not folded (Col. 2, lines 44-45). A non-adhesive central strip is provided and the perforated longitudinal sections are at a distance from the central strip ("fold line"; Col. 2, lines 10-13). The tape is in roll form (see Fig. 1).

Loscuito fails to teach the protective layer comprising multiple slits and the tape being folded upon itself in a transverse direction along a slit.

Hibler, however, teaches a protective tape for protecting corners wherein the protective film is slit ("scored") along the adhesive portions of the substrate. Hibler teaches the use of slits along the protective film layer for the purpose of allowing one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner (Col. 4, lines 30-35). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made, motivated by the desire to properly adhere a tape along the corner portion of a wall, to have provided slits along the adhesive portions a protective film layer of a tape substrate for the purpose of allowing one side of the liner to be peeled and the tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner as taught by Hibler.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Loscuito by slitting the protective film layer along each adhesive portion (thereby making two parallel score lines along each side of the fold line (Fig. 1, #22)) as taught by Hibler in order to allow one side of the liner to be peeled and the

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tape aligned with the corner and then to subsequently allow the second side of the liner to be peeled and pressed on the remainder of the corner.

Tuoriniemi teaches a masking tape for corner structures wherein the tape is folded upon itself in a transverse direction (see Figs. 6(a-e)). Tuoriniemi teaches the rolled construction wherein the tape is folded upon itself for the purpose of allowing the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the tape to be unfolded and bonded along the other edge of the corner – thereby simplifying the application process (Col. 4, lines 46-54). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided a roll of adhesive tape used for corner structures with a tape in a folded over relationship for the purpose of allowing the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the outer adhesive layer to be bonded along the other edge of the corner – thereby simplifying the application process – as taught by Tuoriniemi.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Loscuito by providing the rolled tape in a folded over relationship as taught by Tuoriniemi in order allow the outer adhesive layer to be bonded along one edge of the corner while subsequently allowing the outer adhesive layer to be bonded along the other edge of the corner – thereby simplifying the application process.

17. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vitale (#4,792,473) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307), and further in view of Porter et al. (#5,895,301).

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Vitale teaches a pressure-sensitive adhesive tape as detailed above. The backing layer comprises paper. Although Vitale fails to explicitly state that the tape is hand tearable, it is notoriously well known in the art that paper is hand tearable as evidenced by Porter et al. (Col. 1, lines 64-65). Therefore, given the support of Porter et al., the paper backing inherently possesses the ability to be hand torn transversely to the longitudinal direction of the tape.

18. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loscuito (#5,246,775) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307), and further in view of Porter et al. (#5,895,301).

Loscuito teaches a pressure-sensitive adhesive tape as detailed above. The backing layer comprises paper. Although Vitale fails to explicitly state that the tape is hand tearable, it is notoriously well known in the art that paper is hand tearable as evidenced by Porter et al. (Col. 1, lines 64-65). Therefore, given the support of Porter et al., the paper backing inherently possesses the ability to be hand torn transversely to the longitudinal direction of the tape.

19. Claims 8 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vitale (#4,792,473) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307), and further in view of Avery (#2,373,092), Blok et al. (#6,177,163), and Samuelson (#5,736,001).

Vitale teaches a roll of a pressure-sensitive adhesive tape as detailed above. Vitale fails to teach a cardboard dispenser comprising at least one outlet slot for the tape. It is notoriously well known in the art, however, to provide a dispenser for tapes and/or labels in roll form as evidenced by Avery (Col. 1, lines 31-40; Col. 2, lines 52-55). Avery teaches the use of a cardboard dispenser for the purpose of allowing the roll of tape to be kept in a container that subsequently allows the tape to be dispensed from the container (Col. 1, lines 31-40). Further

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evidence of the notoriously well known use of dispensers for rolled tape can be found in both Samuelson (see Fig. 1) and Blok et al. (see Fig. 1). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have provided a roll of tape with a dispenser for the purpose of allowing the roll of tape to be kept in a container that subsequently allows the tape to be dispensed through the container as taught by Avery.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Vitale by situating the roll of pressure-sensitive tape inside a dispenser as taught by Avery in order to allow the roll of tape to be kept in a protective container that subsequently allows the tape to be dispensed through the container.

20. Claims 8 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loscuito (#5,246,775) in view of Hibler (#6,001,200) and Tuoriniemi (#6,444,307), and further in view of Avery (#2,373,092), Blok et al. (#6,177,163), and Samuelson (#5,736,001).

Loscuito teaches a roll of a pressure-sensitive adhesive tape as detailed above. Loscuito fails to teach a cardboard dispenser comprising at least one outlet slot for the tape. It is notoriously well known in the art, however, to provide a dispenser for tapes and/or labels in roll form as evidenced by Avery (Col. 1, lines 31-40; Col. 2, lines 52-55). Avery teaches the use of a cardboard dispenser for the purpose of allowing the roll of tape to be kept in a container that subsequently allows the tape to be dispensed from the container (Col. 1, lines 31-40). Further evidence of the notoriously well known use of dispensers for rolled tape can be found in both Samuelson (see Fig. 1) and Blok et al. (see Fig. 1). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to

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have provided a roll of tape with a dispenser for the purpose of allowing the roll of tape to be kept in a container that subsequently allows the tape to be dispensed through the container as taught by Avery.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Loscuito by situating the roll of pressure-sensitive tape inside a dispenser as taught by Avery in order to allow the roll of tape to be kept in a protective container that subsequently allows the tape to be dispensed through the container.

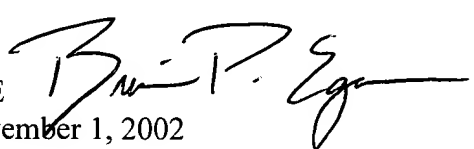
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BPE
November 1, 2002




HAROLD PYON
SUPERVISORY PATENT EXAMINER

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11/1/02